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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,307	10/30/2003	Gregory R. Smith	W-3948	2083
	7590			
	12/13/2004			
Worrel & Worrel St. Croix Professional Center Suite 121 2109 W. Bullard Avenue Fresno, CA 93711-1258			EXAMINER HWU, JUNE	
			ART UNIT 1661	PAPER NUMBER
DATE MAILED: 12/13/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/699,307

Applicant(s)

SMITH, GREGORY R.

Examiner

June Hwu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/31/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

The information disclosure statement filed October 30, 2003 has been considered but crossed out because it is not in format for publishing on the face of a patent.

Drawing

The drawing filed on July 27, 2004 has been approved.

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

In plant application filed under 35 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163(a) because the specification presents less than a full and complete botanical description and the characteristics which distinguish over related known varieties.

More specifically:

- A. The specification does not "particularly point out where the variety of plant has been asexually reproduced". Correction is required.
- B. Age of the observed plant should be disclosed in the specification. Correction is necessary.
- C. Applicant should set forth in the specification that the claimed cultivar is stable and reproduces true to type in successive generations of asexual reproduction.
- D. Applicant should set forth in the specification the average spread of the tree.

- E. Page 5, lines 14-15, Applicant describes the trunk size as "10 inch" diameter but does not disclose at what age and at what the height the measurement was taken.
- F. Page 5, line 17 and page 6, line 6, the recitations "Lenticels-Number- Numerous" do not adequately describe the average number of trunk and branch lenticels per given amount of area.
- G. Page 5, line 18 and page 6, line 8, the recitations "Small" do not quantitatively describe the average size of the lenticels of the trunk and branch.
- H. Applicant should set forth in the specification the shape and color designation with reference to the employed color chart of the trunk and branch lenticels.
- I. Page 6, line 16, the recitation "Marginal Form - Generally - Smooth" is unclear because the term smooth is define as with an even surface or non hairless (see Harris et al, page 171). If the Applicant is referring to the margin of the leaf as not notched or not tooth then the term entire should be imported to the specification (see Harris et al, page 157).
- J. Applicant should set forth in the specification the surface texture, apex and base shape of the leaf.
- K. On page 6, line 18 and on page 7, line 1, the recitation regarding the petiole size is described twice and one of these should be deleted.

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L. Applicant should set forth in the specification a botanical description of the stipules such as average size, shape and color designation with reference to the employed color chart.

M. Applicant should set forth in the specification a botanical description of the spines such as length and color designation, if any.

N. Applicant should set forth in the specification the color designation of the style and stigma.

O. Page 7, line 18, the recitation "Over 60" is vague and does not sufficiently describe the average number or the average range of stamens per flower.

P. Page 7, line 19, the recitation "Small" does not quantitatively describe the average size of the anthers.

Q. Page 7, line 21, the recitation "Red" is vague and does not adequately describe the color designation with reference to the employed color chart of the filaments.

R. Applicant should set forth in the specification the sepal's average size and color designation with reference to the employed color chart.

S. Applicant should set forth in the specification the calyx's shape.

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T. Page 8, line 17, the recitation regarding to the size of the stem should be deleted because it is described above on page 8, line 15.

U. Applicant should set forth in the specification a botanical description of the seed such as average size, shape and color designation with reference to the employed color chart.

The above listing may not be complete. Applicants should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

Claim Rejection

35 USC § 112, 1st and 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to June Hwu whose telephone number is (571) 272-0977. The Examiner can normally be reached Monday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Wang, can be reached on (571) 272-0811. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JH


ANNE MARIE GRUNBERG
PRIMARY EXAMINER